

REMARKS

Claims 1-3 and 10 are amended herein. The amendments to claims 2-3 and 10 are at the examiner's request. Applicants respectfully request that the present amendments be entered, and that the amended claims be considered on their merits. In the alternative, applicants request that the amendments be entered to place the claims in better condition for appeal. The amendment to the specification is also made at the examiner's request.

REJECTION UNDER 35 USC §112, ¶2

Applicants have amended claims 1-3 and 10 to further clarify the invention to which these are drawn. One of skill in the art would recognize that the claims are drawn to a longitudinally elastic tape to which a liquid adhesive has been applied in transverse strips, and which liquid adhesive strips have then been cured to become solid. The cured adhesive strips are the "stiffening strips" therein. The homogeneity of the adhesive is in terms of its liquid state.

Regarding the language "by means of a temperature change" in claim 5, applicants respectfully submit that one of skill in the art would recognize the metes and bounds of this limitation. The appropriate temperature change for curing a particular liquid adhesive would be readily obtainable to the ordinarily skilled artisan in the course of practicing the invention. Accordingly, this language is sufficiently definite for the individual to which it is directed.

Concerning the "loose surface structure" of claims 8 and 9, this language refers to the structure of woven tape commonly employed in the art. The presumption that "loose" refers to an "abraded" surface is not accurate. Rather, the term "loose" refers to the structure of the woven tape on its surface. This would be readily apparent to one of skill in the pertinent art.

Applicants respectfully request that the rejections under 35 USC §112, ¶2 be withdrawn.

REJECTION UNDER 35 USC §102(B)/§103(A)

The examiner rejects claims 1-5 and 8-13 under 35 USC §102(b) as anticipated by, or in the alternative, under 35 USC §103(a) as obvious over, Evans (US 5,522,787). Applicants respectfully traverse these rejections. The present claims contain elements which are neither taught nor suggested by the disclosure in Evans.

To anticipate a claim, each and every element as set forth in the claim must be found, either expressly or inherently described, in the prior art reference (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987)). The Evans reference does not meet this requirement.

The present claims are drawn to a longitudinally elastic tape on which a liquid adhesive has been applied and cured in a transversely oriented direction to form transverse stiffening strips. In contrast, Evans discloses an optionally two-layered flexible planar support having a semi-rigid splint and an adhesive layer (col.1:31-41).

The adhesive is not cured, and serves to hold the support in place once it is applied to a body member (col.1:42-43). Evans does not teach the application and curing of an adhesive in transversely oriented strips. Rather, stiffening is achieved therein either through the planar support, itself, or by including a semi-rigid splint appropriately oriented thereon (col.1:37-38).

To establish *prima facie* obviousness, the examiner must show in the prior art a teaching or suggestion of each claim element, some suggestion or motivation to make the claimed invention, and a reasonable expectation for success in doing so (see, e.g., *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). These requirements have not been met.

Evans does not indicate that the adhesive, itself, could be used to provide the additional support sought from the disclosed stiffener. The stiffener is disclosed therein to be made, appropriately, from "an elongated bar of a semi-rigid material, such as Buna N," or from "a strip of metal or plastic" (col.2:20-21; col.3:19-20). Other similar materials appear to be contemplated by the reference. However, no indication is given in Evans that an adhesive, even one that has been cured, is contemplated to have the necessary characteristics to lend additional stiffness to the starting support. Applicants respectfully submit that one of skill in the art would not view a cured strip of adhesive to "resist bending" to the same degree as a metal or plastic strip (see col.2:22-23).

Accordingly, one so skilled would not find motivation to replace the stiffener of Evans with the cured adhesive of the present invention, and would not find a reasonable expectation for success in doing so.

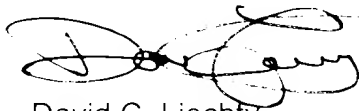
Applicants respectfully request that the rejections under 35 USC §102(b) and §103(a) be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, applicants consider that the rejections of record have been obviated and respectfully solicit passage of the application to issue.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11-0345. Please credit any excess fees to such deposit account.

Respectfully submitted,  
KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'David C. Liechty', is written over the printed name.

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